

REMARKS

By this submission previously pending claims 7, 15 and 16 are amended, and claims 1-6, 9, 13-14 and 20-21 remain canceled without prejudice as to their reintroduction in this or another application claiming priority from this application. No new matter is introduced by the submitted amendments.

Also now submitted is a Terminal Disclaimer.

It is requested in view of now submitted claim amendments, Terminal Disclaimer and the following discussions that all rejections reported in the outstanding Office action be reconsidered and not repeated in any further action issued for this application.

Double Patenting

Claims 7, 8, 11, 12, 15, 18 and 19 are reported in the action as being rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-10 of U.S. Patent No. 6,676,659. These rejections are submitted as being overcome in view of the herewith filed Terminal Disclaimer.

It is noted for this record that the filing of a terminal disclaimer to overcome rejections based on non-statutory double patenting is not an admission that the rejections were proper. See *Quad Environmental Technologies corp. v. Union Sanitary District*, 20 USPQ2d 1392, 1394-95 (Fed. Cir. 1991). The Federal Circuit there stated that the "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." Thus, submission of a terminal disclaimer is not an admission that any of the pending claims are obvious over any claims of U.S. Patent No. 6,676,659.

Accordingly, it is submitted that reported double patenting rejections are overcome.

Claim Rejections – 35 USC § 112

Claims 15-19 are reported rejected under 35 USC § 112, second paragraph, “as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention.” Specifically, it is asserted in the action that:

It is not certain whether the catheter handle includes a catheter and a device comprising a cutting wire extending from a proximal end of the catheter to and connecting to a distal end of the catheter.

It is submitted that claims 15 and 16 have been amended to further clarify recitations of covered structures, and as such these 35 USC § 112, second paragraph, rejections are overcome.

In particular, independent claim 15 now is amended to in part recite: “a rotatable coupling between said catheter handle and a catheter configured to allow free rotation of a proximal end of said catheter; a clamping member configured to engage a proximal end of a device extending through a lumen formed in said catheter to a distal end of said catheter where said device is affixed to said catheter”

Claim Rejections – 35 USC § 102

The outstanding Office action reports that claims 7, 8, 10-12 and 15-19 are rejected under 35 USC § 102(b) as being anticipated by US Patent No. 5,599,300 (Weaver et al.). These reported rejections now are submitted as overcome in view of the following discussions and also by now submitted claim amendments further clarifying recited subject matter for independent claims 7 and 15 from which all other outstanding anticipation rejected claims depend.

As is discussed below independent claims 7 and 15 recite subject matter not disclosed or inherent from the asserted Weaver et al. patent. Therefore, all rejected claims dependent from these independent base claims also recite the same subject matter. (35 USC § 112, fourth paragraph)

Independent claim 7 recites a method of cutting tissue comprising a catheter having a lumen configured to receive an electrosurgical cutting wire, and also comprising “orientating said electrosurgical cutting wire by rotating a handle relative to a proximal end of said catheter, said electrosurgical cutting wire also rotationally orientating a distal portion of said catheter.” Whereas, independent claim 15 recites a catheter apparatus comprising a catheter handle “clamping member configured to engage a proximal end of a device extending through a lumen formed in said catheter to a distal end of said catheter where said device is affixed to said catheter whereby rotation of said handle causes ... rotational orientation of the distal end of said catheter.” Neither a method for rotationally orientating a distal portion of a catheter or providing any structure for causing rotational orientation of the distal end of a catheter are disclosed or suggested in Weaver et al. In fact such method or structures are not asserted in the action as being disclosed or suggested in Weaver et al.

What Weaver et al. disclose is a needle-knife 206 that can be positioned “a desired distance V_d relative to the distal end 215 of the sheath 204” that extends from catheter 12. (See col. 19, lines 21-38, and Fig 35B) No disclosure or suggestion is provided from Weaver et al. for affixing any part, including needle-knife 206, to a distal end of a catheter to effect rotational orientation of a catheter as is recited in claims 7 and 15, and is disclosed in at least paragraphs 0051, 0065 and 0066 of the filed specification.

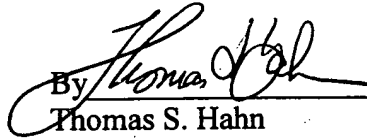
These explicit disclosure failures as to recited subject matter and also the lack of inherent subject matter render Weaver et al. to not be a proper anticipation reference. Accordingly, it is submitted that all reported 35 USC § 102 rejections are overcome.

Conclusion

It is believed that all pending claims are in condition for allowance and a notice of the same is requested. Should the Examiner have any questions, requests or suggestions, he is invited to contact the undersigned attorney at the telephone number set out below.

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Respectfully submitted,

By 
Thomas S. Hahn
Registration No.: 30,845
FULBRIGHT & JAWORSKI L.L.P.
Market Square
801 Pennsylvania Avenue, N.W.
Washington, DC 20004-2623
(202) 662-0200
(202) 662-4643 (Fax)
Attorney for Applicant